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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,347	07/13/2001	Dell 'Eva Marcello	(H)99GU1341U	3573

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EXAMINER

PRATT, HELEN F

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 03/26/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,347

Applicant(s)

MARCELLO, DELL' EVA

Examiner

Helen F. Pratt

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-16 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "with addition of a first liquid", and the claim also recites "and preferably with addition of salt, sugar or salt-like or sugar-like substances" which is the narrower statement of the range/limitation. In claim 11, the phrase "in particular milk substitute drink" is seen to be narrower than "food".

Claim Rejections - 35 USC § 112

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. Whether the seeds or nuts have a shell or coat is seen to be critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claim Objections

Claim 1 is objected to because of the following informalities: The claim should be just one sentence. The sentence on lines 21-23 should be jointed to the body of the claim or made into a separate limitation. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynn (3,697,290).

Lynn discloses a process of making a food product by combining chopped sesame seeds, oil and salt and then acid is added and the composition is mixed. (col. 4, lines 3-29 and col. 6, lines 30-45). No weight is given to the limitation that the substance produced "may be" whipped somewhat with air or nitrogen", as this limitation

Art Unit: 1761

is not required. Claim 1 differs from the reference in the amount of acidulant which is enough to obtain a firmer consistency. However, acids are known to cause coagulation of protein materials, which increases the consistency of a substance. For instance, adding acid to a milk mixture, which contains protein, will result in a cheese product due to the coagulation of the milk. As no amounts are claimed, it is seen that the process is shown. Therefore, it would have been obvious to add an acid to a product as shown by the reference.

Claim 2 requires that the oil originate from seeds or nuts. The reference discloses the use of cottonseed oil. Therefore, it would have been obvious to add an oil from seeds or nuts.

Claim 3 further requires that the seeds or nuts originate from a single plant species and claim 4 that the seeds are sunflower seeds. The reference discloses only chopped sesame seeds in Ex. 1 (col. 6, lines 30-34). As to the use of sunflower seeds in claim 4, attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper

Art Unit: 1761

showing further establishes a coaction or cooperative relationship between the selected ingredients, which produces a new, unexpected, and useful function. In re Benjamin D. White, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221. Therefore, it would have been obvious to use a single plant species and to use other seeds than sesame seeds in the process of Lynn.

Claim 5 further requires that the first liquid can be produced from plants. Oil, of course is produced from the seeds of plants, such as corn and cotton. Therefore, it would have been obvious to use a liquid produced from plants as shown by the reference.

Claim 6 requires that the second liquid is lemon juice. The reference discloses the use of citric acid which is a major acid in lemon juice. No patentable distinction is seen at this time in using lemon juice instead of citric acid. Therefore, it would have been obvious to use a material which contains an acid.

The particular amount of salt and sugar, is seen to have been shown by the reference as is the oil as in claims 7, 8 and 9 (col. 6, lines 30-45). Therefore, it would have been obvious to add particular amounts of ingredients as shown by the reference.

The limitations of the product as in claims 10, 12 and 14 have been disclosed above and are obvious for these reasons. Giving a particular name to a composition does not give patentability to the product.

Claim 13 further requires that a perfuming substance is in the form of an herb or plant constituent. However, the reference discloses the use of caraway seeds which

Art Unit: 1761

are a plant constituent (col. 6, lines 30-34). Therefore, it would have been obvious to add an ingredient which had a particular smell.

Claims 15 and 16 further require a granular constituent which is a coarsely ground ingredient. Lynn discloses the use of ground caraway seed (col. 6, lines 55-61). No patentable distinction is seen in the use of one seed as opposed to another, absent unobvious and unexpected results using the claimed seeds. Therefore, it would have been obvious to use other ground seeds in the composition in place of the sunflower seeds.

Allowable Subject Matter

Claim 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-1978. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on (703) 308-3959. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7718.


Application/Control Number: 09/762,347

Page 7

Art Unit: 1761

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

Hp 3-18-03


HELEN PRATT
PRIMARY EXAMINER